IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : James Crawford   Art Unit : 2141
Serial No. : 09/597,784   Examiner : Kristie D Shingles
Filed : June 19, 2000   Conf. No. : 4992
Title : DIRECT FILE TRANSFER BETWEEN SUBSCRIBERS OF A
        COMMUNICATIONS SYSTEM

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<u>REPLY TO ACTION OF JUNE 26, 2006</u>

Claims 1-40 and 45-78 are pending, with claims 1, 14, 29-31, 36, and 45 being independent.

Claims 1-40 and 45-78 have been rejected as being unpatentable over Donovan (U.S. Publication No. 2004/0193722) in view of van Hoff (U.S. Patent No. 5,761,421) and Miyake (U.S. Patent No. 6,678,341).

Independent claims 1, 29 and 31 each recite, among other features, "establishing an instant messaging communications session with the second client to enable instant messaging communications to be exchanged between the first client and the second client over <u>a first communications channel, the first communications channel passing through the communications system host</u>" (emphasis added), "after establishing the instant messaging communications session, sending, through the communications system host, a request to the second client to establish a direct connection to the second client" (emphasis added), and "**if a user of the second client accepts the request**, <u>establishing, in the instant messaging communications session, a second communications channel</u> between the first client and the second client to enable files to be directly transferred between the first client and the second client, wherein the second communications channel consists of a direct connection to the second client that bypasses the communications system host" (emphasis added). Applicants request reconsideration and withdrawal of the rejection of claims 1, 29 and 31, and their dependent claims, because neither Donovan, van Hoff, Miyake any proper combination of the three describes or suggests establishing an instant messaging communications session to enable instant messaging communications to be exchanged between a first and a second client system over a first communications channel that passes through a communications system host and, after the instant messaging communications session has been established, sending a request to a second client

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system through the communications system host which, **if accepted by a user of the second client system**, establishes, in the same instant messaging communications session, a second communications channel for transferring files that consists of a direct connection to the second client system.

As stated in the response to the Office Action of January 23, 2006, Donovan describes a universal instant messaging system for the Internet. Donovan's system describes a first user (e.g., "Bill") initiating an instant messaging communications session for sending an instant message to a second user (e.g., "Ted") by clicking on the second user's name in a window 50. See paragraph 0033. In response to the first user clicking on the second user's name, an IM manager 34 of the first user sends a message to a SP 18 of the second user (i.e., the instant messaging service provider of the second user) requesting a connection to the IM manager 38 of the second user. See paragraph 0034. In response to receiving the request, the SP 18 may display to the second user a window indicating that the first user is requesting to contact the second user via the IM system and prompting the second user to respond to the request. See paragraph 0034. If the second user accepts the request, an instant messaging communication session is initiated over a connection that is established between the PCs of the two users.

If a peer-to-peer connection is available between the PCs of the two users, the instant messaging communication session is initiated by the IM manager 34 using a direct peer-to-peer connection between the first user PC and the second user PC over which the two users may directly exchange instant messages and files. See paragraphs 0035-37. If a peer-to-peer connection is not available between the PCs of the two users, the instant messaging communication session is initiated using a relay connection that is established between SP 14 of the first user and SP 18 of the second user over which the two users may exchange instant messages and files. See paragraphs 0035-37.

Thus, Donovan describes the acceptance of the request by the second user as a prerequisite for establishing an instant messaging communications session for enabling instant messages to be exchanged between the users. After the request has been accepted by the second user, the instant messaging communications session is initiated over a direct peer-to-peer connection or over a relay connection, depending on what type of connection is available.

Notably, the second user is not described as being able to choose, accept or reject a particular type of connection (i.e., a peer-to-peer connection or a relay connection) over which

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the instant messaging communication session will take place. Rather, the type of connection is determined by factors (in this case, the availability of the peer-to-peer connection as dictated by undisclosed system constraints) other than the input of the user of the PC to which the connection will be made. Moreover, once the instant messaging communication session has been initiated, no further connection requests are exchanged between the users. Accordingly, Donovan does not describe or suggest establishing an instant messaging communications session to enable instant messaging communications to be exchanged between a first and a second client system over a first communications channel that passes through a communications system host and, after the instant messaging communications session has been established, sending a request to a second client system through the communications system host which, **if accepted by a user of the second client system**, establishes, in the same instant messaging communications session, a second communications channel for transferring files that consists of a direct connection to the second client system.

Miyake does not remedy the failure of Donovan to describe or suggest this feature. Miyake describes a multi-mode two-way pager system that enables two-way radio communication between two pager terminals 18a and 18b through a base station 10 and also enables peer-to-peer communication between the two pager terminals 18a and 18b. See col. 5, lines 61-65. Miyake describes a user of the pager terminal 18a being able to start a peer-to-peer communication with a user of the pager 18b. See col. 7, lines 42-46.

In the first two embodiments described by Miyake, once the user of pager terminal 18a attempts to start a peer-to-peer communication with the user of pager terminal 18b, the peer-to-peer communications are assumed to always be able to be executed. See col. 9, lines 5 and 6. In the third through sixth embodiments, however, once the user of pager terminal 18a attempts to start a peer-to-peer communication with the user of pager terminal 18b, the physical positions and surrounding geographic conditions of the pager terminals 18a and 18b dictate whether or not a peer-to-peer connection or, alternatively, a connection through the base station 10 will be established to enable communications between the two users. See col. 9, lines 6-12; col. 10, lines 14-17 and 31-37; col. 11, lines 15-17.

Notably, Miyake does not describe or suggest that the user of pager terminal 18b is able accept or reject a connection/communications request from the user of pager terminal 18a. Moreover, similar to Donovan's teachings, the type of connection (i.e., a connection through the

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base station 10 or a peer-to-peer connection) that is ultimately established between pager terminal 18a and pager terminal 18b is determined by factors (in this case, geographic factors) other than the input of the user of the terminal to which the connection will be made. Accordingly, Miyake, like Donovan, also does not describe or suggest establishing an instant messaging communications session to enable instant messaging communications to be exchanged between a first and a second client system over a first communications channel that passes through a communications system host and, after the instant messaging communications session has been established, sending a request to a second client system through the communications system host which, **if accepted by a user of the second client system**, establishes, in the same instant messaging communications session, a second communications channel for transferring files that consists of a direct connection to the second client system.

Van Hoff describes a system and method for establishing a peer-to-peer communication connection between computer programs from the same security domain. Van Hoff does not describe or suggest user acceptance or rejection of peer-to-peer communication requests, much less describe or suggest the above-recited feature.

For at least these reasons, applicants request reconsideration and withdrawal of the rejection of claims 1, 29 and 31, and their dependent claims 2-13, 32-35, 53, 55, 57, 59, 61, 63, 65, 67, 69, 71, 73, 75 and 77.

Independent claims 14, 30 and 36 each recite, among other features, "establishing an instant messaging communications session with the first client to enable instant messaging communications to be exchanged between the first client and the second client over a first communications channel, the first communications channel passing through the communications system host" (emphasis added), "after establishing the instant messaging communications session, receiving, through the communications system host, a request to the second client to establish a direct connection to the second client" (emphasis added), "**enabling a user to accept the request from the first client**" (emphasis added), and "establishing, in the instant messaging communications session, a second communications channel between the first client and the second client to enable files to be directly transferred between the first client and the second client, wherein the second communications channel consists of a direct connection to the first client that bypasses the communications system host" (emphasis added). For at least the reasons described above, applicants request reconsideration and withdrawal of the rejection of claims 14,

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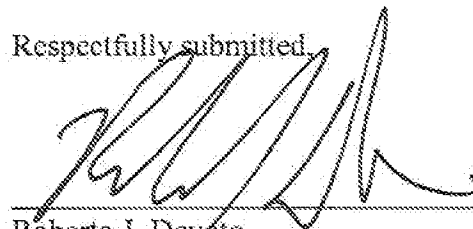Attorney's Docket No.: 06975-
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30 and 36, and their dependent claims 15-28, 37-40, 54, 56, 58, 60, 62, 64, 66, 68, 70, 72, 74, 76 and 78 because neither Donovan, van Hoff, Miyake, nor any proper combination of the three describes or suggests the recited features.

Independent claim 45 recites, "a first graphical user interface element structured and arranged to notify an operator of the second client of a request by the first client to establish a direct connection to the second client, the request being communicated to the second client by a communications system host after establishment of an instant messaging communications session with the first client and the direct connection bypassing the communications system host, the instant messaging communications session enabling instant messaging communications to be exchanged between the first client and the second client over a first communications channel that passes through the communications system host; and a second graphical user interface element structured and arranged to **enable an operator of the second client to authorize the establishment of the direct connection** and a file transfer over the direct connection in the instant messaging communications session" (emphasis added). For at least the reasons described above, applicants request reconsideration and withdrawal of the rejection of claim 45 and its dependent claims 46-52 because neither Donovan, van Hoff, Miyake, nor any proper combination of the three describes or suggests the recited features.

Applicants submit that all claims are in condition for allowance.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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